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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,756

12/04/2006

Harald Schmitt

SCHMITT5

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EXAMINER

LAM, DUNG LE

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,756	Applicant(s) SCHMITT, HARALD	
	Examiner DUNG LAM	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/30/2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)–(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statement submitted on 12/04/2006 has been considered by the examiner (see attached PTO-1449 form).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-7** provides for the methods of “provision of network operator-specific performance features”, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The examiner suggests changing the claims to contain active steps and avoid narrative language.

Claim **1-7** is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim **1-7** rejected under 35 U.S.C. 103(a) as being unpatentable over **Bruss** (WO 99/62282) in view of **Kuniyoshi** (EP 0344989).

Regarding **claim 1**, **Bruss** teaches a method for the provision of network operator-specific performance features of different mobile radio network operators (Abstract) for a mobile radio customer,

- wherein the mobile radio customer has a Smart Card, on which a subscriber relationship of the mobile radio customer with a mobile radio network operator is defined (C17 L24-31),
- wherein on the Smart Card (2) of the mobile radio customer at least two subscriber relationships (3;4) are defined with different mobile phone numbers and with separate performance features (C17 L24-31), and

- each subscriber relationship is assigned in each case to a mobile radio network operator (C3 L23-24, L34-36),

However **Bruss** does not specifically teach an intelligent administration controls of call redirections is performed at each network operator provided for the mobile radio customer, in such a way that the call redirections of all involved networks, except for the network of the current location of the mobile radio customer, always point to the currently active identification and phone number of the mobile radio customer, wherein the call redirections are newly set accordingly with each change of the customer's identification and this renewed programming of the call redirection takes place automatically by the means of appropriate intelligent technologies.

In an analogous art, **Kuniyoshi** teaches a mobile apparatus having multiple IDs and each ID is associated with a system ID number (Abstract). The mobile registers its ID#1 with a coverage area #1 and ID#2 with a coverage area #2 (page 2, C1 L41-54). An active ID is automatically and intelligently selected based on the system ID (page 2, C2 L52-55). Thus when the mobile is located in coverage area #1, then the mobile ID is intelligently selected to be ID#1 (C3 L10-51). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the

invention to combine **Bruss'** teaching of the multiple profiles associated with multiple IDs on a single SIM card to include **Kuniyoshi's** teaching of intelligent selecting a suitable ID based on the system ID of the coverage area that the mobile is currently located because this intelligent ID/profile selection would reduce the burden for the user from having to constantly check the current location and switching the ID manually.

Regarding **claim 2, Bruss and Kuniyoshi** teaches a method according to claim 1, characterized in that on the Smart Card (2), SIM and/or USIM applications exist that are assigned to the respective subscriber relationships (**Bruss** C3 L21-23).

Regarding **claim 3, Bruss and Kuniyoshi** the method according to claim 1, characterized in that only one; subscriber relationship (3 or 4) is active at any given time. Bruss teaches each ID is associated with one profile (SIM1 with IMSI1, SIMn with IMSIn, Fig. 1) and **Kuniyoshi** teaches that only one ID is active in one network (C3 L10-51). Thus Bruss in combination of **Kuniyoshi** teach one profile is active at one time.

Regarding **claim 4, Bruss and Kuniyoshi** method according to claim 1, characterized in that for each existing subscriber relationship (3;4) an assigned subscriber profile is provided in

the home location register HLR (7;8) of the respective network operator (C4 L35, C5 L28-30).

Regarding **claim 5, Bruss and Kuniyoshi** method according to claim 1, characterized in that through intelligent administration and control mechanisms it is ensured that the phone number that is transmitted in the calling line identification presentation function, the number of the mobile radio customer is always used that is specific to the destination network of the call, regardless of the current location of the mobile radio customer, wherein the subscriber being called is always signaled the mobile phone number of the mobile customer that is specific for the given country or network (**Kuniyoshi**, page 2, C2 L52-55 page 2, C3 L10-51).

Regarding **claim 6, Bruss and Kuniyoshi** method according to claim 1, characterized in that the mobile radio customer is assigned to only one mobile box. The examiner broadly interprets a mobile box as the housing of the mobile. The examiner takes official notice that the concept of having the same mobile housing in different network is well known.

Regarding **claim 7, Bruss and Kuniyoshi** method according to claim 1, characterized in that the call redirection in the network of the current location of the mobile radio customer is

Art Unit: 2617

set to a mobile box (9) and when the subscriber relationship (3;4) is switched, the call redirections are automatically reprogrammed by means of intelligent functions (**Kuniyoshi**, page 2, C2 L52-55 page 2, C3 L10-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUNG LAM whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 5:30 pm, Every Other Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617

/Dung Lam/

Examiner, Art Unit 2617